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09/435,748

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JAMES P. BUCKLEY

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62274 7590 02/23/2009

DARDI & ASSOCIATES, PLLC

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EXAMINER

RUTHKOSKY, MARK

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JAMES P. BUCKLEY,  
DANIA I. GHANTOUS, KHANH HOANG,  
CRAIG R. HORNE, and XIANGXIN BI

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Appeal 2009-1004  
Application 09/435,748  
Technology Center 1700

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Decided: February 23, 2009

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Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and  
CATHERINE Q. TIMM, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

This application is remanded to the jurisdiction of the Examining Corps in order for the Examiner to notify Appellants that their reinstatement of the subject appeal is defective.

As background, the application was previously remanded on August 26, 2005 with instructions to the Examiner and Appellants to correct several deficiencies in the record which prevented an informed and meaningful appellate review.

In response to this Remand, the Examiner reopened prosecution via a Non-Final Office Action mailed September 23, 2005.

Appellants responded to this Non-Final Office Action by filing on December 01, 2005 a “Request to Reinstate Appeal” and a “Supplemental Reply Brief”.

According to the Manual of Patent Examining Procedure (MPEP) § 1204.01 (Rev. 3, Aug. 2005); “If an appellant wishes to reinstate an appeal after prosecution is reopened, appellant must file a new notice of appeal in compliance with 37 C.F.R. § 41.31 and a complete new appeal brief in compliance with 37 C.F.R. § 41.37”.

Appellants’ reinstatement of appeal did not follow this MPEP guideline and therefore is defective.

In response to the subject remand, the Examiner must notify Appellants of the above-noted defect and provide them with an appropriate period of time within which to cure the defect. As indicated above, Appellants can cure this defect by filing a new notice of appeal in compliance with 37. C.F.R. § 41.31 and a complete new appeal brief in compliance with 37 C.F.R. § 41.37.

The requirement to file a complete new appeal brief when reinstating an appeal serves the important function of protecting an appellant’s administrative due process rights, which is well-illustrated by the record of this appeal. In the present appeal record, Appellants’ position is represented

by a “Corrected Brief” filed July 02, 2004, a “Supplemental Appeal Brief” filed July 28, 2004, a “Reply Brief” filed January 18, 2005, a “Supplemental Reply Brief” filed December 01, 2005, and a “Reply Brief” filed October 02, 2006. The arguments and authorities presented in support of Appellants’ position in this appeal are dispersed among these five separately filed Briefs. Such dispersal raises the danger that some aspects of Appellants’ position may have been overlooked by Appellants or may be overlooked by this Panel of the Board. Further, this danger is exacerbated by the fact that the foregoing Briefs were filed in accordance with the differing requirements of now obsolete rule 37 C.F.R. § 1.192 and current rule 37 C.F.R. § 41.37. By complying with the MPEP requirement to file a complete new appeal brief in compliance with 37 C.F.R. § 41.37, the danger to Appellants’ administrative due process right will be mitigated.

Upon receiving such an appeal brief, the Examiner must then respond with an appropriate Examiner’s Answer in compliance with 37 C.F.R. § 41.39, to which Appellants may reply via a Reply Brief pursuant to 37 C.F.R. § 41.41.

In summary, this application is remanded to the Examiner for action consistent with our comments above.

Appeal 2009-1004  
Application 09/435,748

REMANDED

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